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Daniel J Sweigard

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EXAMINER

WOOD, KIMBERLY T

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/509,928
Filing Date: October 01, 2004
Appellant(s): SWEIGARD, DANIEL J

James E. Walton,
Daren C. Davis
Brian E. Harris
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed July 7, 2008
appealing from the Office action mailed.

(1) Real Party in Interest

A statement identifying by name the real party in interest
is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals,
interferences, or judicial proceedings which will directly
affect or be directly affected by or have a bearing on the
Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the
brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after
final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the
brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be
reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,248,119	Imura	9-1993
3,710,674	Tabor	1-1973

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-12, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art figures 1A and 1B in view of Imura 5,248,119. Figures 1A and 1B disclose a clip comprising base portion 13, a clamp portion 11 having opposing fingers 21, 23, and 25 that act as springs and form a channel, and a mounting aperture 17, a base having a

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lubricant disposed between the base portion and the structure (specification page 2, line 1), clip operably associated with an aircraft/structure (specification page 2, line 26ff). Figures 1A and 1B disclose all of the limitations of the claimed invention except for the at least two mounting apertures, the polytetrafluoroethylene, and an anti-friction insert member. Imura teaches that it is known to have an anti-friction insert member comprising an elongated shaft portion (near 3), a central channel (where P is received), a longitudinal slot (see figure 2A, and column 3, line 10), a flange on each end (where the arrow for 4 is pointing). It would have been obvious to one having ordinary skill in the art to have modified the applicant's admitted prior art figures 1A and 1B to have included the anti-friction insert as taught by Imura for the purpose of to prevent the tubular member from sliding within the clip. It would have been obvious to one having ordinary skill in the art to have modified Figures 1A and 1B to have an additional mounting aperture to the base portions since such a modification is merely a duplication of parts and generally recognized as being within the level of one skilled in the art. It would have been obvious to one having ordinary skill in the art to have modified the Figures 1A and 1B to have made the insert member of polytetrafluoroethylene, since it has been held to be within the

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general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice since Imura states that "Designated at (4) is a resinous or rubber elastic member (FIGS. 1 and 2) assuming a collar-like, split-bush-like, band-like or tubular configuration..." which provides the motivation to alter the material of Imura to consist of Polytetrafluoroethylene which is a "resinous" material therefore meeting the requirement of Imura. *In re Leshin*, 125 USPQ 416.

Claims 5, 13, and 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art figures 1A and 1B in view of Imura 5,248,119 in further view of Tabor 3,710,674. Applicant's admitted prior art figures 1A and 1B in view of Imura discloses all of the limitations of the claimed invention except for the flanges abutting the finger members. Tabor teaches that it is known to have a split sleeve (44) having flanges (46 and 48) abutting against its receiving member (18) therefore preventing axial movement (see column 4, lines 3ff). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Applicant's admitted prior art figures 1A and 1B in view of Imura to made the flanges to abut the finger member for the purpose of preventing axial movement.

(10) Response to Argument

In response to applicant's arguments in regards to claim 11, from which 12 and 14 depend, that Imura does not disclose "anti-friction insert member" this argument is hereby traversed. The examiner relies on the statement of Imura that "(4) is a resinous or rubber elastic member" within column 3, line 10" provides the evidence that Imura teaches of an "anti-friction insert member". It is well known that "a resinous" member would include "plastic material" which provides anti-friction characteristics inherently as supported by example within Tabor 3,710,674 which proves that is well known and conventional to have a "sleeve 44 is constructed of a suitable anti-friction plastic material, such as the materials known as Teflon or Nylon, each of which has low friction characteristics but each of which is sufficiently rigid and resilient to function as the split sleeve of the present invention".

In regards to applicant's arguments that Imura is "... being fitted or bonded to the seizing walls (3, 3') of the outer peripheral surface of the pipe..." therefore Imura's member 4 frictionally grips the pipe, rather than having anti-friction properties this argument is hereby traversed. The applicant alleges that Imura has to frictionally grip the pipe P however the statement that the applicant relies upon does not definitely

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mean that the insert has to frictionally grip the walls since the statement includes that the insert member 4 is "fitted" to the seizing walls (3,3') or pipe (P). This statement does not necessarily mean the insert member is fixed to the seizing walls or pipe but by definition within Merriam-Webster's Collegiate Dictionary Tenth Edition "fitted" is defined as "shaped to conform to the lines of the body" which by no means as interpreted by the examiner in the broadest sense would inherently teach that the "fitted" insert would frictionally grip the seizing walls (3,3') or pipe (P). Imura as disclosed and in the broadest sense would teach of a "resinous" and "fitted" insert (4) within the walls (3,3') or pipe (P) being of a plastic material sleeve/insert (4) shaped to conform to the lines of the walls (3,3') or pipe (P) as discussed above without being a frictionally gripping member as argued by the applicant. The insert only need to have the shape of the walls (3,3') or pipe (P) without having the characteristics of a friction member as clearly defined in the broadest sense therefore not teaching away from the teaches of Imura as the applicant alleges.

In regards to the applicant's arguments that Imura teach of "each flanges of member 4 are spaced apart from seizing walls 3, 3'. Thus the flanges of member 4 cannot prevent axial movement of member 4 relative to seizing walls 3, 3'", this argument is

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hereby traversed. Applicant argues that Imura teaches away from preventing axial movement of the insert by the flanges however Imura clearly teaches within the specification in column 2, lines 20ff that his invention is drawn to the particular problem of "effectively preventing positional deviations in the lengthwise and peripheral direction on the side of the pipe" which would lead the examiner to believe that the insert flanges structure and spacing would be used to meet the applicant's goal of preventing positional deviations in the lengthwise direction therefore meeting the applicant's limitation of preventing axial movement of the insert not promoting axial movement as alleged by the applicant's arguments. Imura clearly teaches of flanges at each end of the insert (4) which is well known as a conventional means of preventing axial movement of the insert relative to the walls 3,3' as supported by example within Tabor 3,710,674 column 4, lines 3ff which clearly teaches that it is well known that "flanges 6 will prevent substantial movement of the sleeve 2 in the openings 26...".

In regards to applicant's arguments that Tabor is silent with regard to "an anti-friction insert member" and "teaches away from "anti-friction insert member" these arguments is hereby traversed. Tabor 3,710,674 clearly teaches within column 4, lines 38ff that it is conventional and well known to have

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"sleeve **44** is constructed of a suitable anti-friction plastic material, such as the materials known as Teflon or Nylon, each of which has low friction characteristics but each of which is sufficiently rigid and resilient to function as the split sleeve of the present invention".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.

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Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion for combining is found within Imura and Tabor as discussed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/Kimberly T. Wood/
Primary Examiner

September 25, 2008

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